

REMARKS

The Applicants have carefully considered the arguments presented by the Examiner in the Office Action mail January 31, 2007 and, in view of the assertions presented by the Examiner, the Applicants have added new claims which clearly and unequivocally distinguish the present invention over the cited art. In addition, the Applicants have extensively detailed the reasons upon which the claims as originally presented are believed to be in condition for allowance. As a result, the Applicants respectfully request reconsideration of the Examiner's position based upon this amendment and the arguments presented herein.

In the outstanding Office Action, the Examiner has effectively rejected all of the pending claims based upon Diamond in combination with the disclosure found in Food Ingredient News. As stated by the Examiner, Diamond discloses a pan spray which contains grape seed oil and liquid lecithin, while the disclosure of the Food Ingredient News discusses the existence of a dry or powdered lecithin. Using these two references, the Examiner argues that it would have been obvious to one having ordinary skill in the art to substitute the dry lecithin discussed in the Food Ingredient News for the liquid lecithin taught in a pan spray of Diamond, and thereby effectively achieve the subject matter defined in pending Claim 1.

Unfortunately, the Examiner's assertions fail to recognize the inherent differences between dry lecithin and liquid lecithin as well as the difficulties in using dry

lecithin in various products. In addition, the Examiner has also failed to consider the actual disclosure provided by Diamond. When these failures are fully considered, the Applicants' maintain the patentability of Claim 1 becomes readily apparent.

In particular, numerous difficulties, drawbacks, and problems exist in using de-oiled, powdered lecithin as is fully discussed in the pending patent application. The mere fact that Food Ingredient News teaches the existence of dry or powdered lecithin is clearly insufficient to enable one having ordinary skill in the art to immediately know how the new material can be used and how the material will interact with other ingredients.

The mere teaching that dry lecithin exists is insufficient to teach the manner in which it can be used, the quantity, and/or the process for its use. These specific elements form the basis of the pending claims and provide patentable subject matter which has been completely ignored by the Examiner.

Furthermore, the teaching found in Diamond is specifically directed to the use of grape seed oil as the principal ingredient in a pan release spray. In fact, the basic formula taught by Diamond comprises only grape seed oil, a small quantity of flavoring and a propellant. However, as indicated by the Examiner, Diamond also discloses the combination of grape seed oil along with liquid lecithin.

In the formulation employing both grape seed oil and liquid lecithin, grape seed oil is used in a quantity ranging between about 67% and 82%, while the lecithin ranges between about 3% and 7%. Claim 1 of the present application defines a pan release

spray product comprising between about 0.5% and 10% by weight based upon the weight of the entire composition of de-oiled, powdered lecithin and between about 90% and 99.5% by weight based upon the weight of the entire composition of oil. In addition to the fact that the quantities taught by Diamond are strikingly different from the quantities defined in the pending claims of the present application, there is no teaching or suggestion in the cited references which would enable one having ordinary skill in the art to make the substitution considered by the Examiner to be obvious.

In this regard, the Applicants found that one of the difficulties in using dry or powdered lecithin was its inability to dissolve or easily intermix in oil, which is the major constituent of the pan release spray product. In addition, the Applicants have also discovered that in creating a new formulation which employs de-oiled, powdered lecithin, the quantity required for the de-oiled, powdered lecithin is substantially different from the quantity that had previously been used for liquid lecithin. As a result, mere substitution of ingredients is not possible.

In view of these factors, it is evident that the Examiner's assertion of obviousness cannot be sustained. The law is well established that a *prima facie* case of obviousness is only effectively made when the prior art references specifically disclose or suggest the combination proposed by the Examiner. In this regard, the suggestion for the combination being asserted must be found either in the references, themselves, or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5

U.S.P.Q. 2d 1596, 1598-99 (Fed. Cir. 1988). However, undue testing or experimentation must not be required if a claim of obviousness is to be sustained.

As the Court of Appeals for the Federal Circuit found in In re Jones, 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992) a *prima facie* case of obviousness is not established when the evidence that one of ordinary skill in the art would have been motivated to make the modification of the prior art asserted by the Examiner is mere speculation of the Examiner. In this cited case, the Examiner asserted that the claimed herbicide was obvious in view of a prior art reference which disclosed the genus of the claimed material. Although the Board of Patent Appeals affirmed the Examiner, the Court of Appeals reversed the Board, finding that although the claimed herbicide was within the overall genus disclosed in the prior art reference, the structure of the claimed material was sufficiently different from the structure taught by the prior art as to prevent a *prima facie* case of obviousness from being established.

Similarly, in In re Baird, 29 U.S.P.Q. 2d 1550 (Fed. Cir. 1994), the Court cited with approval the decision in In re Jones in finding that a disclosure of a chemical genus does not render obvious any species that happens to fall within the stated genus. In reaching its decision, the Court held that the mere inclusion of a claimed specific compound within the genus of a prior art reference does not render the claimed compound obvious and does not motivate one of ordinary skill in the art to select the specific claimed compound.

When the holdings of these cases are fairly considered, the patentability of Claim 1 over the cited reference becomes immediately apparent. In particular, the references upon which the Examiner has relied may fairly suggest the experimentation with de-oiled, powdered lecithin in a pan spray incorporating grape seed oil. However, the quantity of the ingredients to be employed is not taught by the references, nor is the manner in which the ingredients can be combined. As a result, the combination cannot be considered obvious and Claim 1 should be found to be allowable.

Claims 2-7 are dependent upon Claim 1 and add novel combinations thereto. For this reason, and the reasons detailed above, Claims 2-7 are also believed to be in condition for allowance.

Independent Claim 8 defines a pan release spray product incorporating a non-aerosol finger pump actuated container and a pan release spray composition substantially as defined in Claim 1. For the reasons detailed above, the Applicants maintain that Claim 8 provides a unique combination of features which is not in any way taught or suggested by the prior art references and is also in condition for allowance.

Furthermore, one feature developed by the Applicants which is of particular importance, is the fact that the Applicants discovered that the dry, powdered lecithin can only be dissolved into the oil by heating the oil to between about 120° and 150° F. This teaching is not found in any prior art references cited by the Examiner. In addition, this specific limitation is found in original Claim 9, which is dependent upon independent Claim 8. In view of the fact that no prior art references cited by the

Examiner provides any teaching or suggestion regarding heating the oil component of the formulation in order to enable the dry or powdered lecithin to be added to that oil, the patentability of Claim 9 is immediately apparent.

In addition, Claims 10-13 are dependent upon Claim 9 and add novel combinations thereto. For this reason, as well as the reasons detailed above in reference to Claim 9, these dependent claims are also believed to be in condition for allowance.

In view of the importance of the discovery regarding heating the oil prior to intermixing the de-oiled, powdered lecithin into the oil, Claims 18, 19, 20, 21, and 22 have been added to this pending application. In dependent Claim 18, the heating step is included as an additional process step of the method defined in independent Claim 14. Similarly, Claim 19 is dependent upon Claim 1 and further defines the composition of Claim 1 as being created employing heating of the oil prior to the addition of the de-oiled, powdered lecithin.

Finally, independent Claims 20, 21, and in 22 have been added to this application wherein various combinations of the present invention have been defined, with each combination incorporating a limitation directed to the heating of the oil prior to the addition of the de-oiled, powdered lecithin. In view of the importance of this discovery as well as the complete failure of any prior art reference to teach or suggest this requisite process step, the Applicants maintain that all of the claims incorporating this feature are clearly and unequivocally in condition for allowance.

Finally, originally submitted Claim 14 is an independent claim which defines a process for manufacturing the pan release spray composition of the present invention. In the process defined in Claim 14, the process is defined as comprising the steps of adding the desired quantity of oil to a batch tank equipped with blades for intermixing, slowly sifting the desired quantity of the oiled, powdered lecithin into the oil contained in the batch tank, and thoroughly intermixing the de-oiled powdered lecithin and oil into a uniform composition with the lecithin thoroughly dispersed in the oil. Neither the Diamond nor Food Ingredient News references provide any teaching regarding the process defined in Claim 14. As a result, the Applicants maintain that the specific process defined in Claim 14 is not in any way taught or suggested by these prior art references and Claim 14 should be allowed, along with dependent Claims 15-17.

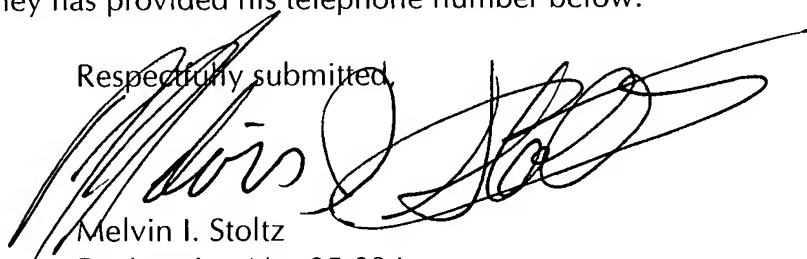
As discussed above, the Examiner's argument ignores the uncertainty in substituting one product for another, regardless of the similarity between the products. In this regard, de-oiled, powdered lecithin cannot be merely substituted for liquid lecithin since the two component are extremely different in their action and interaction with other ingredients. In particular, it has been found that a different quantity of powdered lecithin is employed in formulation which previously had liquid lecithin. Furthermore, the intermixing, and viscosity differences between dry lecithin and liquid lecithin also presents substantial difficulties and interaction uncertainties.

As a result, the Examiner's assertion of an obvious combination of prior art references merely provide one having ordinary skill in the art with a possible alternate

product to employ as a substitute for liquid lecithin, but fails to render a specific combination of ingredients as obvious to that skilled artisan. At best, the references provide a suggestion for experimentation, but fall far short of providing a sufficient teaching upon which to base a rejection of obviousness.

Based upon the foregoing amendment and the arguments set out herein, the Applicants believe that the pending claims are now all in condition for allowance and an early notice of allowability is earnestly solicited. If any questions remain which may be resolved in a telephone interview, Applicants' undersigned Attorney would gladly discuss such issues with the Examiner at the Examiner's convenience. For this purpose, Applicants undersigned Attorney has provided his telephone number below.

Respectfully submitted,

A large, stylized handwritten signature in black ink, likely belonging to Melvin I. Stoltz, is written over the typed name and registration number.

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